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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,672	02/09/2004	Ke-Chi Jang	22171.319	9436

27683 7590 10/10/2006

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EXAMINER	
PEACHES, RANDY	

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/774,672	JANG ET AL.	
	Examiner	Art Unit	
	Randy Peaches	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *8-29 and 31-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-29 and 31-35* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1. ***Claims 8-29 and 31-35*** are rejected under 35 U.S.C. 103(a) as being unpatentable over Havinis et al. (U.S. Patent Number 6,311,069 B1) in view of Zellner et al. (U.S. Patent Number 6,675,017 B1).

Regarding ***claim 8,*** Havinis et al. discloses a telecommunication system, which reads on claimed "wireless communication system," comprising:

- a station having communication logic, which reads on claimed "software," for: receiving a capability request, wherein capability request is interpreted as information regarding location or position information of a mobile station (MS, 20). See column 3 lines 56-62 and column 4 lines 26-30; and
- generating and transmitting a capability request response that includes a status indicator of a non-emergency-services position-determination (NESPD) capability, wherein the NESPD capability is user-selectable. See column 6 lines 4-22 and lines 42-50.

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPD," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number 6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding ***claim 9***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 8***, Havinis et al. continues to disclose wherein the capability request response further includes at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding ***claim 10,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 8***, Havinis et al. continues to disclose wherein the station is a first said MS (20) and the communication logic is first receiving logic (24), the said telecommunication system further comprising a second station, MSC (14) having second communication logic (13) for generating and transmitting the capability

request. See column 5 lines 27-29.

Regarding ***claim 11,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 10***, Havinis et al. continues to disclose wherein the said MSC (14) comprises positioning logic, which reads on claimed "position determining element." See column 6 lines 31-37.

Regarding ***claim 12,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 8***, Havinis et al. continues to disclose wherein the station is a said MS (20). See column 4 liens 49-53.

Regarding ***claim 13,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 8***, Havinis et al. continues to disclose wherein the said station is selected from the group consisting of: a cellular phone, a wireless enabled personal digital assistant, a wireless-enabled personal computer, a GPS device, and a pager. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

Regarding ***claim 14,*** Havinis et al. discloses a method of communicating between telecommunications network stations, comprising:

- receiving at a MS (20) a capability request transmitted by a MSC (14). See column 5 lines 27-40;

- generating at the said MS (20) a capability request reply in response to the capability request, wherein the capability request reply includes a status indicator of a non-emergency-services position-determination (NESPD) capability of said MS (20), the NESPD capability being user-selectable. See column 6 lines 1-12; and
- transmitting the capability request reply to the said MSC (14). See column 6 lines 4-12.

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPD," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number 6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding ***claim 15,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein further comprising:

- generating the capability request at the said MSC (14). See column 5 lines 66-67;
- transmitting the capability request from the said MSC (14) to the said MS (20). See column 5 lines 27-36; and
- receiving the capability request reply at the second station. See column 6 lines 4-12.

Regarding ***claim 16,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose selecting the NESPD capability, wherein the said MS (20) has the option to accept or reject the request. See column 6 lines 13-22.

Regarding ***claim 17,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 16***, Havinis et al. continues to disclose wherein the NESPD capability is selected by the said MS (20) user. See column 6 lines 13-22.

Regarding ***claim 18,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein the said MSC (14) comprises a HLR (26), which reads on claimed "stationary position determining element," and the said MS (20) comprises a wireless mobile device. See column 1 lines 39-43 and column 6 lines 61-67.

Regarding ***claim 19,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein the capability request reply comprises MS (20) identity, which is either and accept or reject response (column 6 lines 14-22), including at least one of a GPS acquisition capability indicator and a position calculation capability indicator. See column 2 lines 28-41.

Regarding ***claim 20,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein generating a position determination request at the said MSC (14) and transmitting the position determination request to the said MS (20) based on an accept of reject response. See column 6 lines 31-38.

Regarding ***claim 21,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein terminating position determination activity at the said MSC (14) based on a default of reject response from the said MS (20). See column 6 lines 23-31.

Regarding ***claim 22,*** Havinis et al. discloses a mobile station (MS, 20), comprising:

- a display (27), which reads on claimed "user-interface," for selecting a non-emergency-services position-determination (NESPD) capability. See column 5 lines 37-40;

- a generator configured to generate a signal, wherein the signal can one of a tone or display of the requesting LA (column 5 lines 32-37) comprising a status indicator of the NESPD capability and zero or more wireless mobile device native capability data; and
- a transmitter configured to transmit the signal to a wireless network element. See column 6 lines 7-12.

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPD," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number 6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding ***claim 23,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 22***, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on an external request received from a wireless network element. See column 6 lines 13-22.

Regarding ***claim 24,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 14***, Havinis et al. continues to disclose wherein the transmitter of the said MSC (14) when a default response is received by the said MS (20), is configured to transmit the signal based on stimulus exclusive of an external request for the status of the NESPD capability. See column 6 lines 23-27.

Regarding ***claim 25,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 24***, Havinis et al. continues to disclose wherein the stimulus comprises a position-related request, which the said MS (20) has rejected. See column 6 lines 13-22.

Regarding ***claim 26,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 22***, Havinis et al. continues to disclose wherein the transmitter is configured to transmit the signal based on a stimulus comprising an external request for the status of the NESPD capability by responding immediately to a request by either accepting or rejecting the request. See column 6 lines 13-22.

Regarding ***claim 27,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 22***, Havinis et al. continues to disclose wherein the zero or more is one or more. See column 3 lines 62-67.

Regarding ***claim 28,*** as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 22***, Havinis et al. continues to disclose wherein the said MS (20) is selected from the group consisting of: a mobile telephone; a personal computer with a wireless modem; a GPS device; a pager; and a wireless-enabled PDA. Havinis et al. discloses a cellular phone. See column 1 lines 39-43.

Regarding ***claims 29***, Havinis et al. discloses a method of operating an element of a wireless communication network, comprising:

- transmitting a non-emergency services position determination message to a mobile station. See column 5 lines 27-36;
- receiving a status indicator from the mobile station, at least indirectly, wherein the status indicator indicates that the mobile station is configured to refrain from providing position information for non-emergency services. See column 6 lines 4-22 and lines 42-50; and
- preventing a plurality of NESPD messages from being transmitted to the said MS in response to receiving the status indicator. See column 6 lines 23-31.

However, Havinis et al. fails to clearly disclose whether the user selection allows the user to enable or disable all requests irrespective of the provider associated with the request.

Zellner et al. discloses in column 3 lines 59-65, wherein the user can block location information, which reads on claimed "NESPD," for individual transmission, for specific transmissions or for all transmissions.

Therefore, at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify the teachings of Havinis et al. (U.S. Patent Number 6,311,069 B1) to include Zellner et al. (U.S. Patent Number 6,675,017 B1) in order to provide the user the flexibility disable or enable the transmission of position information totally to providers, regardless of the type of request.

Regarding ***claim 31***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 29***, Havinis et al. discloses a message from a said NESPD regarding the service that is dependent on the said MS's position within the said network. See column 6 lines 31-38.

Regarding ***claim 32***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 29***, Havinis et al. continues to disclose wherein the said status indicator indicates whether the mobile station is configured to:

- refrain from providing information for all non-emergency services. column 6 lines 4-22 and lines 42-50;
- provide position information for all non-emergency services. See column 2 lines 28-41.

Regarding ***claim 33***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 29***, Havinis et al. continues to disclose wherein the status indicator indicates whether the mobile station is configured to provide or refrain

from providing position information for NESPD in a manner independent of any particular NESPD. See column 6 lines 4-22 and lines 42-50.

Regarding ***claim 34***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 29***, Havinis et al. continues to disclose wherein the element is a Service Mobile Location Center (SMLC), which reads on claimed "position determining entity." See column 2 lines 25-28.

Regarding ***claim 35***, as the combination of Havinis et al. and Zellner et al. are made, the combination according to ***claim 29***, Havinis et al. continues to disclose wherein the status indicator is included in a message further containing native capability data of the said MS. See column 5 lines 32-37.

Response to Arguments

Regarding the 112 rejection in the previous Office Action, based on the Applicant's explanation, the rejection has been overcome.

Applicant's arguments, see Applicants Arguments/Remarks, filed 7/7/2006, with respect to the rejection(s) of ***claims 1-35*** under 35 U.S.C. 102(b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Zellner et al. (U.S. Patent Number 6,675,017 B1).

Claims 8-29 and 31-35 stand rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randy Peaches whose telephone number is (571) 272-7914. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
September 26, 2006

CHARLES APPIAH
PRIMARY EXAMINER